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10/638,231

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John E. Jones

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EXAMINER

BHATNAGAR, ANAND P

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/638,231 | Applicant(s) JONES ET AL. | |
| | Examiner ANAND BHATNAGAR | Art Unit 2624 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/12/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-26, 28-38, 41-43, 47, 48, 51-53, and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) 22-26, 28-36, 42, 43, 52, 53, 58 and 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21, 37, 38, 41, 47, 48, 51, and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08/07/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/04/08 has been entered.

Election/Restrictions

2. Applicant's election with traverse of species 1 (claims 1-9, 11-21, 37, 38, 41, 47, 48, 51, 57, and 59) in the reply filed on 01/12/09 is acknowledged. The traversal is on the ground(s) that the restriction requirement fails to inform the applicant's as to the criteria being used to divide claims and/or the manner in which that criteria are being applied. Examiner will clarify the species for applicant's understanding. Species 2 differs from species 1 since these claims are directly to currency bills wherein each currency bill is "populated with additional subfields" (see claims 22, 42, 52, and 58), which are not limitations of species 1. The requirement is still deemed proper and is therefore made FINAL.
3. Applicant has canceled claims 10, 27, 39, 40, 44-46, 49, 50, 54-56, and 61-68. Claims 22-26, 28-36, 42, 43, 52, 53, 58, and 60 are withdrawn since they belong to a non-elected species. Currently, claims 1-9, 11-26, 28-38, 41-43, 47, 48, 51-53, and 57-60 are pending. Examiner refers to the action below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 37, 38, and 41 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. This is referred to as the “machine or transformation test”, whereby the recitation of a particular machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility (See *Benson*, 409 U.S. at 71-72), and the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity (See *Flook*, 437 U.S. at 590”). While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform an article nor positively tie to a particular machine that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. That is these claims can be performed manually and do not pass the machine/transformation test.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 4, 6-9, 11-13, 16-21, 37, 38, 41, 47, 48, 51, and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Paraskevacos (U.S. patent 7,006,664 B2 will be further referred to as Par.).

Regarding claims 1, 37, 47, and 57: Par. discloses a currency bill scanning device (fig. 5), comprising:

a receptacle for holding currency bills (fig. 5 elements 44-46 and col. 6 lines 33-45, wherein the currency input is read as the receptacle);

means for obtaining an identifier for a transaction involving one or more of the currency bills (col. 2 lines 27-38, wherein a electronic tag of the transaction,

currency, etc. is obtained. This electronic tag is read as the identifier for a transaction);

an image scanner operable to obtain an image from at least one side of a received currency bill and to extract a serial number of the received currency bill from the image (fig. 5, col. 1 lines 57-60, col. 2 lines 46-55, and col. 6 lines 35-55, wherein the serial number of the currency is obtained); and

a processor communicatively coupled to the image scanner, the processor operable to create a data file comprising the one or more currency bill images, wherein each currency bill image is tagged with the extracted serial number of that currency bill and the identifier of the transaction involving that currency bill to allow for the involved one or more currency bills to be subsequently traced by serial number to that transaction (fig. 2., fig. 5, and col. 2 lines 26-63).

Regarding claims 37, 47, and 57: For the feature of “distributing a number of currency bills for that transaction.” Based on the amount in the transaction there will be multiple currency bills for a transaction especially if the amount is high.

Regarding claim 2: The device of wherein the image scanner obtains at least a partial image of each currency bill (fig. 5 element 48).

Regarding claim 4: The device of wherein the image scanner obtains a full image of each currency bill (fig. 5 element 48).

Regarding claim 6: The device wherein the means for obtaining the identifier comprises a data entry device (fig. 2 and col. 5 lines 27-37, wherein a keyboard/keypad is used to enter information).

Regarding claim 7: The device wherein the data entry device is a keypad (fig. 2 and col. 5 lines 27-37, wherein a keyboard/keypad is used to enter information).

Regarding claim 8: The device wherein the data entry device is a card reader (col. 4 lines 56-63, wherein a card reader is used).

Regarding claim 9: The device wherein the data entry device is a biometric scanner (fig. 8).

Regarding claim 11: The device further including a currency bill denomination discriminator (col. 2 lines 27-37, wherein the denomination of the currency is read and compared).

Regarding claim 12: The device wherein the denomination discriminator is operative to extract a bill denomination value from the image (col. 2 lines 27-37, wherein the denomination of the currency is read and compared).

Regarding claim 13: The device further including a transport mechanism adapted to transport the one or more currency bills, one at a time, from an input receptacle past the image scanner, to at least one output receptacle (fig. 5).

Regarding claim 16: The device further including a controller adapted to control the operation of the device (fig. 2 and fig. 5 element 3, wherein the CPU is read as the controller).

Regarding claim 17: The device of claim 1 further including a memory for storing the data file (fig. 5 element 55 and col. 6 line 50-55).

Regarding claim 18: The device further comprising an interface through which the data file is communicated from the device to a computer (figs 2 and 5).

Regarding claim 19: The device wherein the image scanner extracts a denomination of the currency bill that is further included in the data file (col. 2 lines 27-45).

Regarding claim 20: The device of claim 1 wherein the image scanner extracts a Federal Reserve Bank number of the currency bill that is further included in the data file (col. 2 lines 27-45, reads bank numbers).

Regarding claim 21: The device of claim 1 wherein the image scanner extracts a signatory on the currency bill that is further included in the data file (col. 2 lines 27-45, reads bank numbers, reads the signature, etc.).

Regarding claims 38 and 48: The method of claim 37 wherein the distribution transaction comprises a currency bill withdrawal transaction (fig. 2 elements 25-29 and col. 2 lines 27-37, wherein multiple devices are connected which some are for depositing money and some for both depositing money and withdrawing money. The currency entered and/or withdrawn is checked for authenticity).

Regarding claim 41: The method wherein linking comprises forming an image file containing the at least partial image of each currency bill for that transaction along with the serial number of those currency bills and the transaction identifier (col. 2 lines 27-45).

Regarding claim 51: The device of claim 47 wherein the linking includes forming an image file containing the image of each currency bill for that transaction along with the serial number of those currency bills and the transaction identifier (col. 2 lines 27-45).

Regarding claim 59: The device further including a memory for storing the data file (fig. 5 element 55).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paraskevatos (U.S. patent 7,006,664 B2 will be further referred to as Par.).

Regarding claim 3: Par. does not teach the feature of “wherein the partial image is obtained of each side of each currency bill.” This is a well known feature in the art of image processing. Examiner takes OFFICIAL NOTICE. It would have

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been obvious to one ordinary skilled in the art to incorporate this well known feature. One ordinary skilled in the art would have been motivated to incorporate this feature based on the availability of the hardware and/or software available at the time of invention.

Regarding claim 5: Par. does not teach the feature of “wherein the full image is obtained of each side of each currency bill.” This is a well known feature in the art of image processing. Examiner takes OFFICIAL NOTICE. It would have been obvious to one ordinary skilled in the art to incorporate this well known feature. One ordinary skilled in the art would have been motivated to incorporate this feature based on the availability of the hardware and/or software available at the time of invention.

Regarding claim 14: Par. does not teach the feature of “wherein the one or more currency bills are transported by the transport mechanism with a narrow dimension parallel to a direction of transport.” This is a well known feature in the art of image processing. Examiner takes OFFICIAL NOTICE. It would have been obvious to one ordinary skilled in the art to incorporate this well known feature. One ordinary skilled in the art would have been motivated to incorporate this feature based on the availability of the hardware and/or software available at the time of invention.

Regarding claim 15: Par. does not teach the feature of “wherein the at least one output receptacle is a plurality of output receptacles.” This is a well known feature in the art of image processing. Examiner takes OFFICIAL

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NOTICE. It would have been obvious to one ordinary skilled in the art to incorporate this well known feature. One ordinary skilled in the art would have been motivated to incorporate this feature based on the availability of the hardware and/or software available at the time of invention.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Haycock et al. (U.S. patent 6,546,351 B1) for a note processing device.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANAND BHATNAGAR whose telephone number is (571)272-7416. The examiner can normally be reached on M-Th 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anand Bhatnagar/
Primary Examiner, Art Unit 2624
June 21, 2009